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INTRODUCTION AND SUMMARY OF ARGUMENT

Counsel for Synopsys in the *Synopsys v. Ricoh* case and for the defendants in the *Aeroflex v. Ricoh* case (hereinafter “defense counsel”) wished to consult with Dr. Donald Thomas regarding his work on the prior art Design Automation Assistant (DAA) logic synthesis system. Defense counsel had learned from Dr. Thomas that he had worked briefly for Ricoh about a year previously helping Ricoh’s counsel “read through and understand” prior art logic synthesis papers, but that this relationship had ended. Defense counsel recognized that Dr. Thomas might have a conflict of interest as a result of his prior work for Ricoh that could disqualify him from consulting with the defense. Counsel, therefore, pursued the course of action recommended in *Wang Labs. Inc. v. Toshiba Corp.*, 762 F. Supp. 1246, 1250 (E.D. Va. 1991) and *Shadow Traffic Network v. Superior Court*, 24 Cal. App. 4th 1067, 1088, 24 Cal. Rptr. 2d 693, 704-05 (1994). These cases teach that a party considering retaining an expert under these circumstances should make immediate disclosure of its plan to consult with the potentially-conflicted witness so that the question of the expert’s potential conflict can be resolved between the parties before there is any disclosure of confidential attorney-client information belonging to the party that originally retained the consultant. After reaching agreement with Dr. Thomas on the terms of the potential consulting relationship, defense counsel notified Ricoh on July 22 of its retention of Dr. Thomas. See Declaration of Louis Campbell (“Campbell Decl.”)¹, Ex. F (this document is mis-dated July 17 but was sent on July 22). Counsel, however, did not begin substantive consultations with Dr. Thomas. Instead counsel told Ricoh’s attorneys that they would not consult with Dr. Thomas for two weeks to allow Ricoh to present its objections to the proposed arrangement. See Ex. I.

Ricoh has presented no authority indicating that the act of proposing a consulting relationship with Dr. Thomas was sanctionable, particularly when counsel provides the notice discussed in *Wang* and *Shadow Traffic*. Ricoh’s brief instead addresses the question of whether Dr. Thomas is disqualified

¹ Hereinafter, all references to “Ex.” should be understood as references to Exhibits attached to Mr. Campbell’s declaration submitted with this opposition, unless otherwise indicated.

1 from consulting with the defense, *see* Motion for Sanctions at 19:25 – 20:19 (“Sanc. Mot.”), but since
2 defense counsel abandoned its plan to consult with Dr. Thomas in August, that issue is moot.

3 The great bulk of Ricoh’s motion is dedicated to allegations that defense counsel misled either
4 Dr. Thomas or Judge Sleet, who had the *Ricoh v. Aeroflex* case before it was transferred to this Court.
5 In its brief, Ricoh contends with mock solemnity that it takes no pleasure in making these allegations,
6 but is compelled to do so by the evidence. *See* Sanc. Mot. at 1:21-25. That might be credible if there
7 was some merit to Ricoh’s various allegations. Ricoh’s allegations, however, are a grab bag of
8 assertions – some of which are directly contradicted by evidence available in the record (see, *e.g.*,
9 sections III D & V, *infra*) and some of which rely on theories about intent that require wild leaps of
10 logic (see, *e.g.*, sections IV A and IV B, *infra*). A challenge to the integrity of opposing counsel, if it is
11 to be made, must be based on clear and convincing evidence of intentional misconduct. Ricoh’s
12 motion is not.

13 Furthermore, Ricoh has suffered no harm as a result of defense counsel’s unsuccessful effort to
14 consult with Dr. Thomas. Despite Ricoh’s perfunctory allegations to the contrary, no litigation
15 confidences of Ricoh were disclosed by Dr. Thomas. There is no basis in the law to disqualify defense
16 counsel that sought diligently and successfully to prevent such disclosures. Since there was nothing
17 improper in at least exploring the idea of whether Dr. Thomas could consult for defense counsel and
18 Ricoh suffered no harm as a result, there is no basis for the imposition of sanctions.

19 STATEMENT OF FACTS

20 The facts and circumstances surrounding defense counsel’s communications with Dr. Thomas
21 regarding a subpoena served on him, defense counsel’s short-lived plan to consult with Dr. Thomas
22 and the two subsequent hearings before Judge Sleet are described in the pending “Motion Requesting
23 Court Order Lifting Restrictions Imposed by Delaware Court on Deposition of Dr. Donald Thomas,”
24 made by Synopsys and the *Ricoh v. Aeroflex* defendants. A shorter précis of those facts is as follows:

25 Dr. Thomas was one of the principal developers of the Design Automation Assistant logic
26 synthesis system, which Defendants believe is prior art to the patent that Ricoh is asserting in this case.
27 Prior to the initiation of the Delaware lawsuit, in June 2002, Dr. Thomas had briefly served as a
28 consultant for Ricoh, advising them on the substance of various prior art papers. *See* Ex. B at 7, 30. In

1 March of 2003, Defendants first contacted Dr. Thomas by email and asked whether he was available to
2 serve as a consultant to the defense. *See* Ex. B at 1. Dr. Thomas responded by email and told
3 Defendants that he had done related work for Ricoh, and Defendants did not pursue the matter further
4 at that point. *See* Ex. B at 7, 13. Dr. Thomas contacted Ricoh's attorneys at that time and told them
5 that he would not testify for Ricoh at trial. *See* Ex. B at 26, 30; Ex. A at 44:16-46:4.

6 In June, Defendants subpoenaed Dr. Thomas for documents and testimony relating to the prior
7 art Design Automation Assistant logic synthesis system. Unfortunately, because of a clerical error, a
8 copy of the subpoena was not sent to Ricoh. *See* Campbell Decl. at ¶¶ 2-4, Decl. of Wendy Hobbs at
9 ¶3. In response to the subpoena, Dr. Thomas contacted Defendants' counsel by e-mail, asking if
10 defense counsel would compensate him for the cost of reproducing the documents requested in the
11 subpoena, the time of assistant in collecting the materials and his time expended during a deposition.
12 *See* Ex. B at 24; Ex. A at 41:18-42:17. Defense counsel responded that if Dr. Thomas was consulting
13 with Ricoh he should contact them regarding covering his expenses, but that if he was not consulting
14 with Ricoh and Ricoh was not serving as his counsel, that defense counsel was willing to pay these
15 costs. *See* Ex. B at 25.

16 Dr. Thomas replied that he had not consulted with Ricoh since the summer of 2002, that he did
17 not believe that he was in an ongoing consulting relationship with Ricoh and he informed defense
18 counsel that he was sending Ricoh a note officially terminating the agreement that he had with them.
19 *See* Ex. B at 26-31; *see also* Ex. A at 44:16-46:4; 46:21-47:17. In an e-mail a few days later, Dr.
20 Thomas stated that he believed he could be "of great help to the defense." *See* Ex. B at 36. Defense
21 counsel inquired if this meant that he was interested in considering a consulting relationship with the
22 defense. *See* Ex. B at 37. Dr. Thomas then went on a week long vacation. The week Dr. Thomas
23 returned defense counsel and Dr. Thomas reached agreement on the terms under which Dr. Thomas
24 might consult for the defense. *See* Ex. B at 45-48. On July 22, immediately after receiving Dr.
25 Thomas's signed agreement formalizing these terms, defense counsel sent Ricoh's counsel a letter
26 informing them that Dr. Thomas had been retained as a consultant and that the scheduled deposition
27 was being taken off calendar. *See* Ex. F.

1 By a letter dated July 22, Ricoh's counsel objected to Defendants' retention of Dr. Thomas as a
2 consultant and asserted that Dr. Thomas was in possession of Ricoh's confidential and privileged
3 information. Thereafter, in a short five minute conversation, Mr. Louis Campbell, counsel for
4 Defendants, asked Dr. Thomas questions intended to verify whether Dr. Thomas had received from
5 Ricoh any work-product information that might prevent him from consulting for Defendants. This was
6 the only direct oral communication between Dr. Thomas and defense counsel. Defense counsel took
7 pains to avoid disclosure of the particulars of what materials Ricoh had supplied Dr. Thomas while
8 trying to ascertain whether this information was public or represented work product of Ricoh's
9 counsel. See Ex. B at 45-48, 51-52 and July 23 telephone conversation described in Ex. E. Dr.
10 Thomas reviewed the materials and identified them by type in a reply e-mail, which indicated that the
11 materials were not confidential attorney work product. See Ex. B at 52.

12 The issue of whether defense counsel could consult with Dr. Thomas was raised in a hearing
13 held before Judge Sleet on July 30. At the end of the hearing, Judge Sleet ordered defense counsel to
14 produce copies of their correspondence with Dr. Thomas to Ricoh (and a privilege log of any
15 documents withheld for privilege), and ordered Dr. Thomas to appear for a deposition limited to the
16 subject matter of his dealings with defense counsel. The correspondence was produced to Ricoh (since
17 no documents were withheld for privilege, no privilege log was prepared), and Dr. Thomas's
18 deposition was taken. All evidence demonstrated that there had been no communication of any Ricoh
19 confidences from Dr. Thomas to defense counsel.

20 Thereafter, hoping to put the matter to rest, defense counsel informed Ricoh that they were
21 abandoning any effort to use Dr. Thomas as a consultant and would instead take his deposition only as
22 a fact witness on the DAA prior art. Ricoh, again strenuously object and raised the issue with the
23 Court again during a telephone conference held on August 28, in which a variety of different discovery
24 issues were addressed. On this occasion, acting without having seen any of the evidence, the Court
25 ordered defense counsel to produce its internal communications regarding Dr. Thomas's retention for
26 an *in camera* inspection. Contrary to what Ricoh has contended in its motion, (see Sanc. Mot. at
27 17:18-18:7), the Court did not order defense counsel to prepare a privilege log of the documents that it
28

1 was to supply for *in camera* review. The very next day, before Defendants had an opportunity to
 2 present the requested documents, the Delaware court transferred the case to this District.

3 ARGUMENT

4 I. LEGAL STANDARDS

5 A. Ricoh must prove by clear and convincing evidence that defense counsel contacted 6 Dr. Thomas with bad faith intent to obtain confidential information.

7 Ricoh must present clear and convincing proof of misconduct by defense counsel before any
 8 drastic sanction, including imposition of attorney fees or disqualification of counsel, can be imposed.
 9 *See, e.g., Shepherd v. American Broadcasting Companies, Inc.*, 62 F.3d 1469, 1478 (D.C. Cir. 1995)
 10 (“[F]or those inherent power sanctions that are fundamentally penal—dismissals and default
 11 judgments, as well as contempt orders, awards of attorneys’ fees, and the imposition of fines—the
 12 district court must find clear and convincing evidence of the predicate misconduct.”); *Gates Rubber*
 13 *Co. v. Bando Chem. Indus., Ltd.*, 167 F.R.D. 90, 106 (D. Colo. 1996); W. Schwarzer, W. Tashima & J.
 14 Wagstaffe, *Federal Procedure Before Trial* at ¶17:174.1 (2003) (“Schwarzer”). Furthermore, Ricoh
 15 must prove that defense counsel acted in bad faith to support an order sanctioning defense counsels
 16 conduct. *See Zambrano v. City of Tustin*, 885 F.2d 1473, 1478 (9th Cir. 1989) (“A specific finding of
 17 bad faith by the trial judge or magistrate must accompany the sanction order in all such case.”); *see*
 18 *also Primus Automotive Fin’l Services, Inc. v. Batarse*, 115 F.3d 644, 650 (9th Cir. 1997); Schwarzer at
 19 ¶¶17:170d, 17:177. Finally, any remedy must be carefully fashioned to provide redress directed to any
 20 proven bad faith conduct. *See Navellier v. Sletten*, 262 F.3d 923, 947 (9th Cir. 2001) (sanctions under
 21 Fed. R. Civ. P. 37(b)(2) must be just and “must be specifically related to the particular ‘claim’ which
 22 was at issue in the order to provide discovery”); *Lewis v. Telephone Employees Credit Union*, 87 F.3d
 23 1537, 1558-59 (9th Cir. 1996) (holding that the district court’s decision to prohibit the testimony of an
 24 expert witness who had *ex parte* communications with an opposing party was not carefully fashioned).

25 II. COUNSEL’S FAILURE TO TIMELY SERVE RICOH WITH DR. THOMAS’S 26 SUBPOENA WAS INADVERTENT NOT SANCTIONABLE MISCONDUCT.

27 Defense counsel immediately disclosed to Ricoh its retention of Dr. Thomas. This disclosure,
 28 however, was complicated by the fact that, as a result of an accidental oversight, Ricoh was not sent a

1 copy of Dr. Thomas's subpoena at the time it was served. The failure to make timely service on Ricoh
 2 was inadvertent, not an "error of judgment" as Ricoh alleges. *See* Sanc. Mot. at 12:19-22, 13:10-24.
 3 Because the failure to serve Ricoh was accidental and Ricoh did not suffer any harm as a result of the
 4 delayed notice, there is no basis for sanctioning defense counsel for this unintentional action.

5 There is no question that the failure to serve was accidental and not intentional. Synopsis
 6 presents, with this brief, declarations from Louis Campbell and Wendy Hobbs, Mr. Campbell's legal
 7 assistant, explaining how the accident occurred. *See* Hobbs Decl. at ¶¶ 2-3; Campbell Decl. at ¶¶ 2-4.
 8 Even without this testimony, however, defense counsel's behavior at the time indicates that counsel
 9 intended Ricoh to receive notice of Dr. Thomas's subpoena and was unaware that notice had not been
 10 given. Of particular significance is the fact that Ricoh first learned of the subpoena to Dr. Thomas
 11 when defense counsel sent Ricoh a letter stating that Dr. Thomas had been retained and that the
 12 deposition resulting from the subpoena was being taken off the calendar. *See* Ex. F. Likewise, Mr.
 13 Campbell encouraged Dr. Thomas to seek Ricoh's assistance in responding to the subpoena, if he was
 14 still working for Ricoh. *See* Ex. B at 25. To believe, as Ricoh contends, that this failure to serve Ricoh
 15 was intentional one would have to believe that Mr. Campbell intentionally withheld notice of the
 16 subpoena for some nefarious purpose, then encouraged Dr. Thomas to disclose the existence of the
 17 subpoena to Ricoh and then ultimately "blew the whistle" on himself by disclosing the existence of the
 18 subpoena in a letter to Ricoh. This scenario makes no sense.

19 Ricoh presents no evidence that the failure to provide timely service of Dr. Thomas's subpoena
 20 was intentional, and suggests no motive or rationale for this alleged intentional omission.² Instead,
 21 Ricoh raises the unrelated and irrelevant question of whether it is sufficient for compliance with Rule
 22 45(b)(1) that parties be given notice of a third party subpoena directly after this has been served. *See*
 23 Sanc. Mot. at 13:12-19. Defense counsel does not dispute that Ricoh should have been given notice of
 24
 25

26 ² If defense counsel, counter-factually, had wanted to communicate with Dr. Thomas without
 27 involving or engaging Ricoh, it defies logic to think that it try to initiate this contact by serving Dr.
 28 Thomas with a subpoena. If Dr. Thomas had been working for Ricoh, one would expect that he would
 turn to Ricoh's counsel for assistance in responding to any subpoena.

1 the subpoena served on Dr. Thomas but through clerical error was not. The timing of the notice not
2 given is irrelevant.³

3 Because the failure to give Ricoh notice of Dr. Thomas's subpoena was accidental, there is no
4 basis for imposing any sanction on defense counsel. Furthermore, Ricoh has suffered no harm from its
5 delayed notice of the subpoena. None of Ricoh's confidences were revealed as a result of the
6 subpoena (see, *e.g.*, section IV B, *infra*) and if Ricoh and Dr. Thomas wish to renew their consulting
7 relationship, they are free to do so.

8 **III. THERE IS NO BASIS IN FACT OR LAW FOR DISQUALIFICATION OR SANCTION**
9 **OF DEFENSE COUNSEL FOR ITS DEALINGS WITH DR. THOMAS.**

10 There is nothing sanctionable in any aspect of defense counsel's dealings with Dr. Thomas.
11 The fact that counsel proposed consulting with Dr. Thomas is not sanctionable. The case law imposes
12 two obligations on parties seeking to retain experts who *may* pose a conflict-of-interest problem. They
13 must carefully avoid seeking disclosures of confidential information from the expert's earlier
14 representation, and must make early disclosure to opposing counsel of its intentions to consult with the
15 expert. Because defense counsel observed both of these requirements, there is no basis for sanctioning
16 counsel merely for considering the possibility of consulting with Dr. Thomas.

17 Furthermore, nothing in the substance of defense counsel's communications with Dr. Thomas
18 warrants the imposition of sanctions. The evidence clearly demonstrates that none of Ricoh's
19 confidential information was transmitted to defense counsel. There is, therefore, no basis for
20 disqualifying defense counsel, and Ricoh's assertion that the Court should presume that confidential
21 information was exchanged, even in the face of clear evidence that it was not, has no foundation in the
22 law.

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26 ³ Defense counsel's practice, on other occasions, of giving Ricoh fax notice of subpoenas
27 immediately after they were served rather than before does not demonstrate that counsel intended to
28 provide no notice of Dr. Thomas's deposition. Counsel's practice, at worst, delayed Ricoh's receipt of
two subpoenas by a handful of days.

1 Finally, Ricoh alleges that defense counsel should be sanctioned for specific communications
 2 that Ricoh alleges were intended to mislead Dr. Thomas. Ricoh's allegations are based on obvious
 3 mischaracterizations of the communications, and are without merit.

4 **A. Defense counsel acted properly in making an immediate notification to opposing**
 5 **counsel of its plans to consult with Dr. Thomas.**

6 The facts show that the defendants and Synopsys did nothing improper in their dealings with
 7 Dr. Thomas or Ricoh justifying sanctions. Synopsys determined that Dr. Thomas had worked for
 8 Ricoh in the past but was no longer working for them, reached agreement with him on the terms of a
 9 consulting relationship and then announced to opposing counsel that they had done so, without
 10 beginning any kind of substantive consultations with Dr. Thomas. In marked contrast, the cases cited
 11 by Ricoh establish that that a party, or its counsel, can be sanctioned or disqualified when counsel does
 12 substantive work with the conflicted person without prior disclosure to the other party.

13 In *Shadow Traffic*, Latham & Watkins consulted Deloitte & Touche to provide expert witnesses
 14 for an upcoming trial. See *Shadow Traffic*, 29 Cal. Rptr. 2d at 694-95. Deloitte & Touche, however,
 15 had already had discussions with the other party in the case regarding work on the matter. See *id.* The
 16 appeals court decision holds that it was proper to disqualify Latham. It noted, however, that the
 17 problem could have been avoided if Latham had disclosed its intention to consult with Deloitte &
 18 Touche to opposing counsel:

19 "To discharge [the obligation of protecting confidential information] and at the
 20 same time properly represent its client Shadow, if Latham & Watkins wished to
 21 employ Deloitte & Touche, it should have contacted [opposing counsel] upon
 22 learning of the latter's discussion(s) with Deloitte & Touche. Latham &
 23 Watkins failed to take that simple step.

24 *Id.* at 705. What the appeals court proposes as proper conduct is exactly what defense counsel did.

25 Ricoh's cited case *Cordy v. Sherwin-Williams Co.* 156 F.R.D. 575 (D.N.J. 1994), is inapposite.
 26 *Cordy* involves a situation in which one party actually worked with an expert who had previously
 27 consulted for the other side. *Cordy*, 156 F.R.D. at 577-78.. Opposing counsel learned of this work only
 28 after it was already well underway. See *id.* at 578-79 (at ¶¶ 20-21). The *Cordy* court advised that the
 problem could have been avoided if the counsel wishing to consult with the expert had identified their
 intention to opposing counsel. See *id.* at 584.

1 Ricoh cites *Terrebonne, Ltd. v. Murray* as providing the basis for its request for fees based on
2 defense counsel's contact with Dr. Thomas. However, *Terrebonne* involves a situation in which
3 counsel falsely represented his allegiances. In *Terrebonne*, Mr. Bayer, an attorney, held himself out as
4 counsel for one group of parties (New Hogan Lake Investors) when in fact he was simultaneously
5 representing another party (*Terrebonne*) that was contemplating action against the New Hogan Lake
6 Investors. See *Terrebonne, Ltd. v. Murray*, 1 F. Supp. 2d 1050, 1056-1058, 1067-1068 (E.D. Cal.
7 1998). The other cases that Ricoh cites, *Actel Corp. v. Quicklogic Corp.*, 1996 U.S. Dist. LEXIS
8 11815 (N.D. Cal. 1996) and *In re Complex Asbestos Litigation*, 232 Cal. App. 3d 572, 283 Cal. Rptr.
9 732 (1991), involve situations in which personnel worked for, or as, counsel representing one party to
10 a suit and then switched employers and did substantive work with counsel on the opposite side of the
11 matter without giving their former employers proper notice of the altered allegiance. Dr. Thomas
12 never had substantive communications with defense counsel, the *Aeroflex* defendants or Synopsys, and
13 Ricoh was given proper notice of the proposed consulting relationship, so these cases are inapplicable.

14 Ricoh argues that defense counsel made an "error of judgment" in failing to make an
15 investigation into the nature of Dr. Thomas's communications with Ricoh before signing a consulting
16 agreement with him and disclosing their intention to consult with Dr. Thomas to Ricoh. See Sanc.
17 Mot. at 14:16-25 (so-called "error 5"). It is not certain if Ricoh's complaint is that defense counsel
18 signed a consulting agreement with Dr. Thomas – but did no more – before disclosing their plan to
19 consult with Dr. Thomas or that defense did not do a full inquiry into Dr. Thomas's communications
20 with Ricoh before disclosing their intention to consult with him. The latter course would plainly be
21 fraught with peril, and is contrary to the guidance of *Wang* and *Shadow Traffic* that early disclosure to
22 opposing counsel is best. Since Ricoh now alleges that asking Dr. Thomas to identify the types of
23 documents he received from Ricoh was sanctionable error (see Sanc. Mot. at 14:26 – 15:12), it cannot
24 argue that defense counsel erred by not asking similar questions before Ricoh was notified of counsel's
25 plan to consult with Dr. Thomas. If Ricoh's objection is that defense counsel and Dr. Thomas entered
26 a formal retention agreement before the proposed consulting relationship was disclosed, Ricoh presents
27 no case authority indicating that this is sanctionable misconduct.

28

B. There is no basis for the Court to make an assumption that defense counsel received Ricoh confidential information.

Ricoh alternatively asks that the Court presume, even in the absence of any supporting evidence, that Dr. Thomas disclosed confidential information to defense counsel. *See* Sanc. Mot. at 21:4-10. None of the case law that Ricoh cites supports the view that the Court might, or should, ignore factual evidence demonstrating that there has not been a disclosure of confidential information, and presume such a disclosure.

In each of the cases cited by Ricoh, the court found that the second counsel had substantive communications with the conflicted expert or employee that justified adopting a presumption that confidential case strategy information had been conveyed. *See Shadow Traffic*, 29 Cal. Rptr. 2d at 703-704 (counsel had substantive conversations with conflicted expert regarding opponent's damages theory); *Actel Corp. v. QuickLogic Corp.*, 1996 U.S. Dist. LEXIS 11815 at *12-*13 (N.D. Cal. 1996) (paralegal with knowledge of opponents case switched to opposing counsel's law firm and was not effectively screened from the matter); *Complex Asbestos*, 283 Cal. Rptr. at 737 (same); *Cordy*, 156 F.R.D. at 578-79 (conflicted expert provided preliminary opinion and did \$14,500 of work for new counsel); *MMR/Wallace*, 764 F. Supp. at 715 (conflicted witness had substantive conversation with second counsel). These cases explicitly state that any presumption that confidential information has been communicated is rebuttable. *See Complex Asbestos*, 283 Cal. Rptr. at 746-47; *Shadow Traffic*, 29 Cal. Rptr. 2d at 703; *Actel*, 1996 U.S. Dist. LEXIS 11815, at *25; *MMR/Wallace*, 764 F.Supp. at 726 (suggestion in prior cases that presumption might be irrebuttable was dicta).

In the present case there have been no substantive communications between defense counsel and Dr. Thomas and no occasion, therefore, for Dr. Thomas to convey any case strategy information that he might have received from Ricoh to defense counsel. Furthermore, there is no reason for the Court to make any presumptions about the content of the communication between Dr. Thomas and defense counsel, which occurred exclusively by e-mail or regular surface mail, with the exception of voice messages regarding scheduling and one brief telephone conversation. *See Campbell Decl.* at ¶7. Counsel and Dr. Thomas have both provided independent descriptions of that conversation, which are

entirely consistent.⁴ The Court, therefore, has a verbatim transcript of the communications between counsel and Dr. Thomas. The defense urges the Court to review this communication for itself. *See* Ex. B. That review will reveal that the communication was strictly limited to logistical and procedural matters and that counsel explicitly cautioned Dr. Thomas to avoid discussing his substantive communications with Ricoh. *See* Ex. B at 47 (sixth para.), 51.

1. Dr. Thomas's statements about the general character of his work for Ricoh do not justify the imposition of sanctions.

Ricoh alleges that defense counsel should be disqualified because they inquired into the general character of the materials Dr. Thomas had received from Ricoh and in particular as to whether the materials were published. *See* Sanc. Mot. at 21:10-16. Acting on defense counsel's instruction that he not identify the specifics ("title, author, dates, etc.") of the documents, Dr. Thomas replied that he had received "patents," "published articles," and "one [document] that appears to be a rough draft of corporate literature." *See* Ex. B at 52.

Ricoh's argument that this communication requires imposition of sanctions is meritless since the bare fact that Dr. Thomas received technical articles and patents from Ricoh does not constitute a disclosure of confidential attorney-client information. Ricoh relies on the rule set out in *Complex Asbestos Litigation* to justify its demand for disqualification of counsel. Sanctions are appropriate under the rule of *Complex Asbestos Litigation* only when "employees or agents of attorneys go to work for opposing counsel and bring confidential attorney-client information with them." *Strasbourgger Pearson Tulcin Wolff Inc. v. Wiz Tech., Inc.*, 69 Cal. App. 4th 1399; 82 Cal. Rptr. 2d 326, 334 (1999) (emphasis in original). The fact that Ricoh gave Dr. Thomas certain types of documents to review is a predicate fact that helps determine the nature of the relationship between Dr. Thomas and Ricoh. That fact, however, does not rise to the level of "confidential attorney-client information." Even if Dr. Thomas was serving as a non-testifying expert, and his communications with Ricoh were, therefore, shielded from discovery under Fed. R. Civ. P. Rule 24(b)(4), defense counsel would still be entitled to

⁴ It is worth noting that Dr. Thomas did not have access to the description of the telephone conference provided by Synopsys' counsel before his deposition, and that Synopsys' counsel did not confer with Dr. Thomas before his deposition.

1 discover information about the general “nature of the documents, communications or things” had
 2 between Ricoh and Dr. Thomas. *See* Fed. R.Civ. P., Rule 24(b)(5); *Aptargroup, Inc. v. Owens-Illinois,*
 3 *Inc.*, 2003 U.S. Dist. LEXIS 13047, at *4 - *6 (N.D. Ill. 2003). This discovery allows the side
 4 asserting the protection of the Rules to establish the preconditions for the protection, and defense
 5 counsel to challenge their application. *See Aptargroup*, 2003 U.S. Dist. LEXIS 13047 at *6 - *8.

6 Ricoh also contends that defense counsel must be disqualified because Dr. Thomas told defense
 7 counsel that he had told Ricoh that he did not intend to testify on their behalf at trial. *See* Sanc. Mot. at
 8 21:14-16. Defendants and their counsel cannot, however, be sanctioned for the disclosure of this
 9 information, because this information was also simply a predicate fact about Dr. Thomas’s status in the
 10 litigation, and not a privileged communication containing “attorney-client” confidences. Furthermore,
 11 defense counsel did not cause this information to be revealed. Defense counsel had only inquired into
 12 whether Dr. Thomas was in an ongoing consulting relationship with Ricoh, which was a necessary
 13 question for counsel to ask in order to determine if it could properly compensate Dr. Thomas for his
 14 expenses incurred in responding to the subpoena, as he had requested. *See* Ex. B at 25. Dr. Thomas
 15 gratuitously included in his reply the information that he had told Ricoh that he would not testify for
 16 them. *See* Ex. B at 26. The inquiry by defense counsel was perfectly appropriate, even necessary, and
 17 the fact that Dr. Thomas revealed this additional information in his answer cannot be the basis for
 18 sanction.

19 **2. Sanctions are not warranted where Ricoh elicited Dr. Thomas’ testimony**
 20 **regarding his view of Ricoh’s patents.**

21 Ricoh also claims that Dr. Thomas must have discussed the substance of his work for Ricoh
 22 with defense counsel because defense counsel has stated in papers filed with this Court that Dr.
 23 Thomas’s testimony indicates that he told Ricoh that their patent claim was not meritorious. *See*
 24 Notice to Court Re Order Requiring Delivery of Documents, filed Oct. 30, at 2, n.1, and Motion
 25 Requesting Court Order Lifting Restrictions On Deposition of Dr. Thomas, (“Thomas Depo. Mot.”)
 26 filed December 2, at 4:6-14; *see also* Sanc. Mot. at 21:16-18. Ricoh’s argument completely ignores
 27 the fact that defense counsel’s discussion of Dr. Thomas’s views has always been based exclusively on
 28 testimony that Ricoh’s own counsel elicited at Dr. Thomas’s deposition. *See* Thomas Depo. Mot. at

4:6-14. Defense counsel never discussed Ricoh's patent with Dr. Thomas. *See* Campbell Decl. at ¶7. To the extent that defense counsel had any expectation that Dr. Thomas might have negative views regarding Ricoh's patent, that expectation was based exclusively on Dr. Thomas's apparent desire to consult for defense counsel and counsel's own independent evaluation of Ricoh's patent and prior art. *See id.* For Ricoh to allege that defense counsel's citation to testimony elicited by Ricoh is a tacit admission that Dr. Thomas disclosed his conclusions regarding Ricoh's patent (see Sanc. Mot. at 21:16-18) is simply dishonest.

C. Communication with Dr. Thomas regarding Dr. Kowalski's telephone number was not improper.

Ricoh alleges that defense counsel made an "error of judgment" in responding to Dr. Thomas's e-mail in April 2003 that suggested that defense counsel might contact Dr. Thaddeus Kowalski to determine if he could serve as a potential expert. *See* Sanc. Mot. at 12:23-13:9. Defense counsel urges the Court to review the correspondence to which Ricoh refers, which is located at pages 13 through 23 of Exhibit B of Mr. Campbell's declaration, so that the Court can see for itself the frivolous nature of Ricoh's allegations. The only information that Mr. Campbell requested from Dr. Thomas was the telephone number for Dr. Thaddeus Kowalski, and Mr. Campbell makes this request only in response to Dr. Thomas's suggestion that Synopsys contact Dr. Kowalski as a possible expert. *See* Ex. B at 14-15. The other two e-mails sent by Mr. Campbell are polite "thank you" e-mails. *See* Ex. B at 17, 22. Contrary to Ricoh's assertions, nothing that Mr. Campbell did for his part in this correspondence violates any California ethical rule or any provision of the Federal Rules.

Asking Dr. Thomas for the telephone number of a potential expert that he proposed to defense counsel is not a violation of either the Federal Rules of Civil Procedure or the California Rules of Professional Conduct. Federal Rule 26(b)(4) served as the basis of the sanction in the *Campbell Industries v. M/V Gemini*, 619 F.2d 24, 27 (9th Cir. 1980), decision cited by Ricoh. Federal Rule 26(b)(4) limits the circumstances in which an opponent can have access to the facts and opinions held by an expert retained by an adverse party. *See* Fed. R. Civ. P. Rule 26(b)(4). The Rule 26 prohibitions do not extend, however, to facts known to the expert prior to, or independently of his work on behalf of the adverse party. *See Atari Corp. v. Sega of America*, 161 F.R.D. 417, 421-22 (N.D. Cal. 1994). *See*

1 *also* Advisory Committee Notes to section 26(b)(4) (“[m]aterials assembled in the ordinary course of
2 business ... or for other nonlitigation purposes are not under the qualified immunity” of section 26(4)).

3 Rule 2-100 of the California Rules of Professional Conduct may, alternatively, serve as the
4 basis for sanctioning *ex parte* communications with an expert, as the Ninth Circuit held in *Lewis*, 87
5 F.3d at 1557-58. Rule 2-100 forbids communications between counsel and parties represented by
6 another attorney, but is, appropriately, limited to communications relating to “the subject of the
7 representation.” Dr. Kowalski’s telephone number was not developed by Dr. Thomas in connection
8 with his work for Ricoh and it is not the subject of the litigation. It is, therefore, not covered by either
9 of Rule 26(b)(4) or Rule 2-100. Communication of this sort regarding a matter not related to the
10 subject matter of the litigation is not improper and Ricoh has provided no basis in law for sanctioning
11 Mr. Campbell’s request for the telephone number of a former colleague of Dr. Thomas.

12 **D. Ricoh’s allegations that defense counsel misled Dr. Thomas and instructed him to**
13 **terminate his relationship with Ricoh are false.**

14 Ricoh asserts that defense counsel misled Dr. Thomas into believing that Ricoh did not intend
15 to rely on Dr. Thomas as an expert (see Sanc. Mot. at 14:1-9), and that counsel “instructed” Dr.
16 Thomas to terminate his consulting agreement with Ricoh (see Sanc. Mot. at 14:10-15). There is no
17 factual basis for either of these allegations, which are directly contrary to the evidence of the e-mail
18 communication between defense counsel and Dr. Thomas.

19 Defense attorney Mr. Campbell made no representations at all to Dr. Thomas about his
20 relationship with Ricoh. Instead, counsel *inquired* from Dr. Thomas what the status of his relationship
21 to Ricoh was. *See* Ex. B at 25, 28. Ricoh, however, undeterred by the absence of any evidence for its
22 theory concocts a basis from unwarranted speculation that there is unstated subtext in Dr. Thomas’s
23 July 7 e-mail. There Dr. Thomas wrote:

24 “I have not been contacted by Ricoh (Dickstein Shapiro ...) for consultation since last
25 summer. I spoke with them briefly on the phone this March, when you sent your
26 original email to me. I told them I wouldn’t be an expert witness for them during
27 trial.

28 “They have not offered to serve as my counsel during the deposition, and I assume
that they know that you subpoenaed me for the documentation and deposition. Have
they listed me as a consultant?

1 See Ex. B at 28. Like Dr. Thomas, Mr. Campbell believed that Ricoh had been served with a copy of
2 the subpoena. See Campbell Decl. at ¶ 4. Any response that Mr. Campbell made as to Dr. Thomas's
3 implicit question as to why he had not been contacted by Ricoh would have, therefore, been pure
4 speculation. Instead, Mr. Campbell responded:

5 "I take it from your email that you do not believe yourself to be in an ongoing
6 consulting relationship with Ricoh. They have not listed you as a consultant in this
case.

7 See Ex. B at 28. Mr. Campbell's statement that Dr. Thomas had not yet been identified as a consultant
8 was entirely accurate and in no way intended to mislead Dr. Thomas. Ricoh had supplied Defendants
9 with an initial disclosure statement that identified a number of persons with knowledge of facts
10 relevant to the litigation. Mr. Campbell based his answer that Dr. Thomas had not been listed as a
11 consultant based on his review of that list. See Campbell Decl. at ¶ 9.

12 Ricoh argues that Mr. Campbell's response was a deception because he should have understood
13 Dr. Thomas's question "Have they listed me as a consultant?" as an inquiry into whether Dr. Thomas
14 appeared on Ricoh's pre-trial list of witnesses. See Sanc. Mot. 14:3-6. There is absolutely no
15 justification for supposing that Dr. Thomas intended his question to have this particular meaning. In
16 the same e-mail in which Dr. Thomas inquired as to whether he has been listed as a consultant, he told
17 Mr. Campbell that he had told Ricoh that he would not appear as a witness on their behalf. See Ex. B
18 at 26. Based on this statement, it would be irrational for Mr. Campbell to interpret "Have they listed
19 me as a consultant?" as "Have they listed me on a witness list?"

20 Ricoh's contention that defense counsel instructed Dr. Thomas to terminate his consulting
21 agreement is also directly rebutted by the e-mail communication between Mr. Campbell and Dr.
22 Thomas. Defense counsel invites the Court to review the relevant history for itself at pages 24 through
23 36 of Exhibit B to the Campbell Declaration. That history demonstrates that, far from encouraging Dr.
24 Thomas to terminate his consulting agreement, defense counsel encouraged Dr. Thomas to contact
25 Ricoh for assistance in responding to the subpoena. See Ex. B at 25.

26 Dr. Thomas initiated e-mail communication with defense counsel after he received the
27 subpoena. He stated that he was tracking down the documents requested by counsel and inquired
28 about reimbursement for the cost of photocopying, the time spent by his assistant in retrieving the

1 requested materials and his personal time during a deposition. *See* Ex. B at 24.⁵ Defense counsel
 2 responded that “[i]f you are no longer a consultant for Ricoh and Ricoh will not serve as your counsel
 3 during the deposition nor work with you prior to the deposition, we may be willing to pay your costs
 4 for copying documents and time spent at the deposition.” *See* Ex. B at 25. Defense counsel advised
 5 said that if Dr. Thomas was still in a consulting relationship with Ricoh he should contact Ricoh about
 6 covering his costs. *See id.* Dr. Thomas responded with the statement that he believed that his
 7 relationship with Ricoh had come to an end. *See* Ex. B at 30.

8 Mr. Campbell neither instructed nor induced Dr. Thomas to terminate his relationship with
 9 Ricoh. Dr. Thomas approached defense counsel seeking compensation for his expenses. Mr.
 10 Campbell explicitly instructed Dr. Thomas to contact Ricoh regarding reimbursement if he was serving
 11 as their consultant. If Dr. Thomas was no longer serving as a consultant for Ricoh, Mr. Campbell
 12 agreed to compensate him for his time spent at a deposition, at his normal consulting rate. Mr.
 13 Campbell could not offer to pay Dr. Thomas if Dr. Thomas was still consulting for Ricoh, as that
 14 would create an obvious conflict of interest problem. There is no inducement for Dr. Thomas to
 15 switch sides in Mr. Campbell’s e-mail, since Mr. Campbell offers nothing more than what Ricoh
 16 presumably would have paid Dr. Thomas, if his consulting relationship with them had been ongoing.
 17 Mr. Campbell did not hold out to Dr. Thomas the possibility of consulting work. That was not
 18 considered until Dr. Thomas first suggested that he could be “of great help to the defense” in an e-mail
 19 sent after he had already elected not to renew his relationship with Ricoh. *See* Ex. B at 36.

20 **IV. RICOH’S ALLEGATION THAT DEFENSE COUNSEL MISLED JUDGE SLEET IS**
 21 **MERITLESS AND SHOULD BE REJECTED.**

22 **A. There is no factual basis for Ricoh’s allegation that counsel misled Judge Sleet**
 23 **about the timing of its questions of Dr. Thomas.**

24 Ricoh contends that Defendants’ counsel misled the Court by asserting that they had inquired
 25 into whether Dr. Thomas had received confidential materials or information about case strategy from

26
 27 ⁵ The fact that Dr. Thomas apparently did not contact Ricoh to seek reimbursement for these costs or
 28 Ricoh’s assistance during the requested depositions, is explained by Dr. Thomas’s subsequent
 statements that he believed his relationship with Ricoh to have ended. *See* Ex. B at 30.

1 Ricoh, and that this inquiry had taken place “*before* Synopsys retained Dr. Thomas.” Sanc. Mot. at
2 16:10-11.

3 Ricoh bases this assertion on the second paragraph from the following statement made by Mr.
4 Kelley, an attorney for the defense, at the July 30, 2003 hearing:

5 “Whether [Dr. Thomas received confidential information from Ricoh], obviously
6 counsel for plaintiff is indicating that he did receive that information. Sitting here, I
7 have no idea who’s correct on that dispute. But having asked Dr. Thomas, well, if what
8 he said is true, we should be able to use his services under the relevant case law and so
9 what we did is say we’re interested in retaining you, but we’re going to notify the other
10 side. We’re not going to do anything about the fact that we want to work with you.
11 We’re not going to consult with you. We’re not going ask to ask [sic] for your opinions
12 yet. We are going to give them notice we want to enter into this relationship, which is
13 how we ended up where are today.

14 “Yes, I was aware that we were certainly aware there was a possibility that he might
15 have a conflict of interest, but he had indicated he had not received any such information
16 that would create a conflict. If that’s true, we wanted to get into that consulting
17 relationship.

18 Ex. D at 15:5-21.

19 Ricoh contends that the second paragraph contains a representation that counsel conducted an
20 investigation before it signed an agreement with Dr. Thomas. There is, however, no explicit statement
21 about the chronology of events in Mr. Kelley’s statement. Ricoh’s argument is based entirely on the
22 inference that when Mr. Kelley told the Court that “we wanted to get into that consulting relationship,”
23 the fact that the “consulting relationship” was referred to as prospective was intended to convey that
24 Dr. Thomas had not yet signed a retention agreement with Defendants.

25 Ricoh’s construction of Mr. Kelley’s words falls apart when the entire transcript is examined.
26 In a part of the transcript preceding the language quoted by Ricoh, Mr. Kelley told the Court that
27 Defendants had notified Ricoh of their plans to consult with Dr. Thomas “as soon as we had retained
28 Dr. Thomas.” Ex. D at 12:22–13:2. In the first paragraph of the passage quoted above, Mr. Kelley
describes that defense counsel told Dr. Thomas that “we are not going to consult with you” but that
counsel will notify Ricoh of its intentions. In that context, “consult,” had to refer to actual substantive
conversations and not the mere act of signing a retention agreement, since Mr. Kelley had already told
the Court that Dr. Thomas signed a retention agreement before Ricoh was notified. Given this, Mr.

1 Kelley's statement that defense counsel wished to "get into that consulting relationship" was clearly
 2 referring to future discussions with Dr. Thomas regarding matters pertaining to the defense of the
 3 case.⁶ When Mr. Kelley told Judge Sleet that Defendants wished to "get into that consulting
 4 relationship," he was referring to prospective consultation on the merits of the litigation between
 5 Defendants and Dr. Thomas that had not yet – and still has not – occurred.

6 **B. There is no factual basis for Ricoh's allegation that counsel misled Judge Sleet**
 7 **about the nature of questions asked of Dr. Thomas and his communications in**
 8 **response.**

8 Ricoh next alleges that defense counsel misled Judge Sleet when Mr. Kelley stated that:

9 "we asked [Dr. Thomas]: Have you received anything confidential from Ricoh, did you
 10 talk to them about case strategy? We understand that these are two kinds of things that
 11 create a conflict of interest. And he assured us he had not.

11 Ex. D at 14:25-15:4.

12 These remarks identify two types of communication that, had they occurred, might serve as the basis
 13 for disqualifying Dr. Thomas. He could be disqualified, Mr. Kelley posited, if he had received
 14 confidential materials from Ricoh's counsel or if he talked to Ricoh's counsel about case strategy. Mr.
 15 Kelley's representation that defense counsel had inquired into whether either of these types of
 16 communication had occurred was based on Mr. Campbell's telephone conversation with Dr. Thomas
 17 on July 23 and the follow-up e-mails with Dr. Thomas in which he enumerates the type of materials he
 18 received. *See* Ex. B, at cover letter (2nd para. describing telephone conference) and 51-52.

19 Dr. Thomas's follow-up e-mail identified the types of documents that he had received from
 20 Ricoh as "patents," "published articles" and "one [document] that appears to be a rough draft of
 21 corporate literature." *See* Ex. B at 52. This confirms Mr. Kelley's representation that Dr. Thomas told
 22 counsel that he had not received documents containing confidential attorney-client information.

23 There is no comparable e-mail confirming what is stated in Mr. Kelley's August 5 letter to Mr.
 24 Hoffman, which states that Mr. Campbell inquired into whether Dr. Thomas had received any

26 ⁶ It is also worth noting the similarity between the phrase "we want to enter into this relationship" in
 27 the previous paragraph quoted above, which plainly refers to future consultation after signing the
 28 agreement, with the phrase "we wanted to get into that consulting relationship." The two passages
 were obviously intended to have similar meaning.

1 information related to case strategy and that Dr. Thomas had said that he had not. *See* Ex. B, cover
 2 letter. During Dr. Thomas's deposition, Ricoh's counsel did not specifically inquire into whether he
 3 believed he had received information about "case strategy." Dr. Thomas, however, did provide
 4 deposition testimony characterizing the work that he did for Ricoh, and this testimony is consistent
 5 with his representation to Mr. Campbell that he had not received such information. Dr. Thomas
 6 testified:

7 "I feel that my work for Ricoh was in patent analysis. I taught them certain things as if
 8 they had come to a classroom and I taught them something. They would ask a question, I
 9 would explain something. If somebody else asked me those same questions, as people
 have done over the years and people will over other years, I would feel free to answer
 those questions.

10 Ex. A at 35:2-8. *See also* Ex. A at 70:18-71:15.

11 Dr. Thomas presumably would have not said that the questions asked by Ricoh were like those he
 12 heard in his classes at Carnegie-Mellon if those questions directly related to Ricoh's strategy for
 13 litigating this case.

14 Ricoh argues that the Court should infer that Mr. Kelley must have mischaracterized defense
 15 counsel's communications with Dr. Thomas because Dr. Thomas testified that he regarded his
 16 conversations with Ricoh as "confidential." *See* Sanc. Mot. at 16-17. This ignores a much more
 17 likely, and innocent, explanation for Dr. Thomas's testimony. Disqualification of an expert for conflict
 18 of interest requires the two-part showing that (1) the expert had a prior relationship with the other party
 19 in which there was a reasonable expectation of confidentiality, and (2) that "confidential attorney-
 20 client information" was exchanged. *See Complex Asbestos Litigation*, 283 Cal. Rptr. at 746-47. *See*
 21 *also Strasbourger Pearson*, 82 Cal. Rptr. 2d at 333 (confidential information must be in the nature of
 22 "attorney-client" confidences to justify disqualification). The fact that conversations were conducted
 23 as part of a confidential relationship does not in itself establish that "confidential attorney-client
 24 information" was exchanged. Mr. Kelley's colloquy with the Court, which was focused on the
 25 question of whether Dr. Thomas had "received anything confidential from Ricoh [or] talk[ed] to them
 26 about case strategy," was plainly focused on the content of the information exchanged, *i.e.* the second
 27 element of the disqualification inquiry. In contrast, the testimony from Dr. Thomas that Ricoh refers
 28 to relates to the fact that Dr. Thomas believed that the work he had done for Ricoh was to be held in

confidence, *i.e.* that the first element of the disqualification test, the existence of a confidential relationship. For example, Dr. Thomas testified that he regarded the fact that Ricoh had given him specific articles was confidential information – even though the materials received themselves were not confidential in content. *See* Ex. A at 75:8-25. When asked whether he had “received confidential information from Ricoh’s counsel,” Dr. Thomas gave the somewhat equivocal answer that “I feel that the fact that they were bringing these articles to my attention was confidential.” *See* Ex. A at 76:16-23. Dr. Thomas’s testimony seems, therefore, to be directed to a different issue than that addressed by Mr. Kelley before Judge Sleet.

Ricoh also represents that Mr. Kelley’s statement to Judge Sleet is contradicted by his August 5 letter to Mr. Hoffman describing defense counsel’s one telephone call with Dr. Thomas on July 23. Ricoh alleges that “[f]ive days after making his misrepresentation to the Court, Mr. Kelley admitted that Dr. Thomas had said he did not know whether or not he had received confidential information.” *Sanc. Mot.* at 16:24-26. This characterization relies on highly selective, and misleading, citation from the letter. Here is what the letter actually says:

“Mr. Campbell then asked if Dr. Thomas had received anything confidential from Ricoh or its counsel. Dr. Thomas stated that he did not think he had but that he was not entirely certain. Mr. Campbell then asked Dr. Thomas to investigate to determine the answer to this question.

See Ex. B (cover letter from Mr. Kelley to Mr. Hoffman, dated Aug. 5). Dr. Thomas made his investigation and communicated the result the next day by e-mail, identifying the classes of documents received (patents, published articles and one rough draft of corporate literature). *See* Ex. B at 52. Ricoh’s selective citation in its brief to the sentence about Dr. Thomas’s initial uncertainty, without any reference to his subsequent e-mail resolving that uncertainty, is simply dishonest.

V. **RICOH’S ARGUMENT THAT DEFENDANTS ARE IN WILLFUL VIOLATION OF A COURT ORDER TO PRODUCE A PRIVILEGE LOG IS MERITLESS.**

Ricoh also contends that Defendants have ignored Judge Sleet’s instructions that counsel produce a privilege log of all internal communications regarding Dr. Thomas. Judge Sleet never issued such an order. The record shows that Judge Sleet imposed two obligations on the Defendants in the *Aeroflex* case and counsel. First, the Court issued a written order on July 31 requiring Defendants

1 to either produce or describe on a privilege log, all documents relating to communications between
2 Defendants' counsel and Dr. Thomas. *See* Ex. H at ¶ 2. Defendants produced all such documents
3 and, therefore, did not produce a privilege log. *See* Ex. B (first paragraph of cover letter)

4 At an August 28 discovery hearing, Ricoh argued that the July 31 order extended not only to
5 counsel's communications with Dr. Thomas, but also to counsel's *internal* communications regarding
6 Dr. Thomas. Defendants' counsel Frank DiGiovanni responded that Ricoh's construction of the July
7 31 order was not correct and Judge Sleet agreed that "Mr. DiGiovanni's reflections do seem to
8 comport with my recollection" of the intended scope of the order. *See* Ex. C at 10:9-11:25, 11:25-
9 12:9. Nothing in the subsequent deliberations at the August 28 hearing indicates that Judge Sleet ever
10 reconsidered this view. Furthermore, when Judge Sleet required production *in camera* of defense
11 counsel's internal communications regarding Dr. Thomas, he did not indicate that he was enforcing or
12 implementing the July 31 order and he did not state that Defendants should supply Ricoh with a
13 privilege log covering the documents produced for *in camera* review. Defendants complied with
14 Judge Sleet's order to produce counsel's internal communications for *in camera* review by producing
15 the documents to Judge Chesney on October 30, 2003.

16 Ricoh states "Judge Sleet rejected the argument ... that the July 31 order did not require the
17 preparation of a privilege log." Sanc. Mot. at 17:25-27. If this was true, of course, Ricoh ought to be
18 able to point to a place in the transcript where Judge Sleet made this rejection. Instead, Ricoh cites
19 generally to pages 26-32 of the transcript. Reference to a "privilege log" appears in only one place in
20 that passage – when Ricoh's counsel Mr. Brothers mentions it in passing when he requests that the
21 Court alter the deadline for the two-page letter Ricoh is authorized to file under the July 31 order. *See*
22 Ex. C at 26:21-27:3. Judge Sleet says that this alteration is acceptable, but there is nothing in this
23 interchange to lead one to the conclusion that Judge Sleet is *sotto voce* ordering Defendants to prepare
24 a privilege log covering their internal communications. Had anyone attached any significance to Mr.
25 Brother's reference to "privilege log" at this point – which is debatable, since the issue is never
26 discussed again in five full pages of discussion regarding Judge Sleet's order that follow – one would
27 naturally have read it as a reference to the privilege log discussed in the July 31 order.

1 Elsewhere, in a portion of the transcript that Ricoh does not cite, Ricoh's counsel Mr. Hoffman
2 asks the Court to construe the July 31 order to require production of a privilege log that included all of
3 the internal communications of defendants' counsel, conceding, it would appear, that there is a
4 question as to whether the July 31 order reaches internal communications. Mr. Hoffman told the
5 Court:

6 "And we are asking that the Court – the way we believe the order read, we ask that the
7 Court require the Howrey & Simon firm and defendants to provide a list of the privileged
8 documents."

9 Ex. C at 22:15-18. In the next sentence Mr. Hoffman requested that the Court require that Defendants'
10 counsel provide copies of internal communication regarding Dr. Thomas for *in camera* review by the
11 Court. Judge Sleet conspicuously granted the latter request but said nothing about the former. *See* Ex.
12 C at 22:7-23:7.

13 Ricoh asks this Court to find Defendants in contempt for their failure to follow Ricoh's
14 construction of the July 31 order. *See* Sanc. Mot. at 18. This request is wholly without merit, since
15 Ricoh's argument that Judge Sleet ever ordered preparation of a privilege log extending to defense
16 counsel's internal documents is unsupported by the record. The only word from Judge Sleet directly
17 addressed to the July 31 order indicates that he agreed with defense counsel's view on its scope and
18 opposed Ricoh's. *See* Ex. C at 10:9-25, 12:7-9.

19 **VI. THERE IS NOTHING SANCTIONABLE IN DEFENSE COUNSEL'S REQUEST THAT
20 IT BE ALLOWED TO TAKE "ORTHODOX" DISCOVERY OF DR. THOMAS.**

21 Ricoh contends that defense counsel's desire to depose Dr. Thomas as a fact witness regarding
22 his knowledge of prior art logic synthesis systems is a sanctionable "error of judgment." *See* Sanc.
23 Mot. at 12:19-22, 15:13-20. Established precedent, however, authorizes defendants to take discovery
24 of facts known to a witness and opinions held by them independently of their consulting work for an
25 opposing party.

26 As explained in the motions noticed on December 2, 2003 by Synopsys and the defendants
27 seeking relief to take Dr. Thomas deposition, Dr. Thomas had direct involvement in the development
28 of extremely important prior art logic synthesis systems. *See* Thomas Depo. Mot. at 1:15-19; 4:2-4. It
is well established that even if an expert serves as a non-testifying consultant for one side of the

1 litigation, the other parties may still have “have ‘orthodox’ discovery of facts known and opinions held
2 by the expert prior to the time he began to work for the plaintiff on the litigation, but not with respect
3 to information or opinions developed thereafter.” *Eliassen v. Hamilton*, 111 F.R.D. 396, 402 (N.D. Ill.
4 1986). *See also Atari Corp*, 161 F.R.D. at 422. Since Synopsys is allowed under law to take Dr.
5 Thomas’s testimony on the question of the character of prior art systems, the fact that it is standing on
6 its right to do so cannot be an “error of judgment” or the basis for sanction.

7 Contrary to what Ricoh contends (see Sanc. Mot. at 15:18-20), Defendants have already
8 indicated that they have no intention to question Dr. Thomas on the substance of his work for Ricoh.
9 *See Thomas Depo. Mot. at 9:21-10:8*. Ricoh argues that obtaining Dr. Thomas’s testimony regarding
10 the character of prior art systems necessarily encroaches on the work that Ricoh did for Dr. Thomas.
11 *See Sanc. Mot. at 22:3-13*. Ricoh ignores the fact that Dr. Thomas has a long history of work in this
12 area, and testified that the questions that Ricoh asked him were in the same areas and of the same sort
13 that addressed regularly in his professional career. *See Ex. A at 35:2-8* (“I taught them certain things
14 as if they had come to a classroom and I taught them something. ... If somebody else asked me those
15 same questions, as people have done over the years and people will over other years, I would feel free
16 to answer those questions.”). Having paid Dr. Thomas to explain his understanding of the prior art,
17 Ricoh did not thereby lockup access to information and opinions that Dr. Thomas had formed
18 independently of his retention by Ricoh.

19 Ricoh’s brief also suggests that Dr. Thomas’s testimony on factual issues should be suppressed
20 as a sanction. *See Sanc. Mot. at 19-22*. Ricoh cites a number of cases that address the question of
21 whether an individual should be disqualified from serving as an expert on behalf of one party if he has
22 a conflict of interest. No case cited by Ricoh stands for the proposition that an individual disqualified
23 from serving as an expert is barred from giving testimony on matters of which they have independent
24 knowledge that predates the prior retention that creates the conflict of interest. In fact, in *Wang* the
25 district court disqualified an individual from serving as an expert on the basis of a conflict of interest,
26 but held that he could be deposed on matters of which he had independent, pre-existing knowledge.
27 *See Wang*, 124 F.R.D. at 13-14.

28

VII. RICOH'S FEE REQUEST IS UNJUSTIFIED AND SHOULD BE DENIED.

Last, Ricoh's request for an award for fees and costs related to this issue is legally unjustified and should be denied. Since Synopsys was justified in its course of action regarding Dr. Thomas, an award of costs is unjustified. Since counsel was justified in its actions with respect to Dr. Thomas, Ricoh is not entitled to fees or costs it has incurred. In fact, Ricoh's request fees and costs in seeking to prevent Synopsys from obtaining relevant discovery is perverse and should be rejected.

For a proposed consultant or expert to be disqualified by his prior work, the party seeking disqualification must establish that: (1) the party reasonably assumed a confidential relationship had existed between the expert and the party, and (2) "confidential attorney-client information" was exchanged. *See Complex Asbestos Litigation*, 283 Cal. Rptr. at 746-47. *See also Strasbourger Pearson*, 82 Cal. Rptr. 2d at 333 (confidential information must be in the nature of "attorney-client" confidences to justify disqualification). Given Dr. Thomas's representation that he had ceased consulting for Ricoh about a year previously (see Ex. B at 26), and that his work for them had been "to help them read through and understand various papers of the time," (see Ex. B at 7), it was not frivolous for defense counsel to question whether the second element required for disqualification of an expert, that he had received "confidential attorney-client information," was present. Ricoh's expenses in addressing that question, up until the time at which Synopsys abandoned its efforts to consult Dr. Thomas, were not the result of unreasonable "multiplication" of the proceedings, as Ricoh argues. *See Sanc. Mot.* at 22:21 – 23:3. Likewise, Synopsys' counsel did not exhibit "reckless conduct" in the manner in which they raised the question. In providing immediate notification to Ricoh of their desire to consult with Dr. Thomas, they followed the procedure endorsed in *Wang* and *Shadow Traffic*.

Furthermore, the sanction that Ricoh proposes is grossly excessive in scope because the great bulk of the fees that Ricoh seeks to recover were expended after Synopsys and the *Aeroflex* defendants had already agreed to abandon their plan to consult with Dr. Thomas. None of the efforts undertaken by Ricoh after this point have yielded anything that provides further relief to Ricoh or further advances the issues in this case. Ricoh's second petition to Judge Sleet, to seek in camera review of the internal communications of defense counsel regarding Dr. Thomas – based on unsubstantiated dark theories of

1 “fraud on the court” (see Ex. C at 28:15-29:16) – has produced nothing of value. The fees associated
 2 with the preparation of the present motion are included in the fees that Ricoh now seeks to impose as
 3 sanctions. *See* Decl. of Ken Brothers, at ¶39. This motion requests substantive relief in the form of
 4 disqualification of defense counsel and an absolute bar on any discovery from Dr. Thomas, as well as
 5 the imposition of monetary sanctions. Because the requests for substantive relief lack any foundation
 6 in law or fact and cannot, therefore, be granted, there is no basis for awarding Ricoh fees expended on
 7 bringing this meritless motion. *See Navellier*, 262 F.3d at 947; *Lewis*, 87 F.3d at 1558-59.

8 CONCLUSION

9 For the reasons stated above, Ricoh’s motion should be denied.

10 Dated: December 16, 2003

Respectfully submitted,

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12
13 By: /s/ Christopher L. Kelley

14 Christopher L. Kelley

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 16 INCORPORATED, ET AL.